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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,082	06/24/2004	Shuichi Kitamura	542-012.010	5847
4955	7590	04/07/2006	EXAMINER	
WARE FRESSOLA VAN DER SLUYS & ADOLPHSON, LLP BRADFORD GREEN BUILDING 5 755 MAIN STREET, P O BOX 224 MONROE, CT 06468			BERNSHTEYN, MICHAEL	
			ART UNIT	PAPER NUMBER
			1713	

DATE MAILED: 04/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

CA

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/500,082	KITAMURA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Michael Bernshteyn	1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>06/24/04, 09/27/04, 05/06/05</u> | 6) <input type="checkbox"/> Other: ____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

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were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

1. Claims 1-6 and 8-19 are rejected under 35 U.S.C. 102(b) as being anticipated by JP-A-43-1487.

With regard to the limitations of claims 1-6 and 11, JP-A-43-1487 discloses an easily cold water-dispersible polyvinyl alcohol film comprising (A) a high hydrolysis polyvinyl alcohol having a degree of hydrolysis of at least 97% by mole, (B) a low hydrolysis polyvinyl alcohol having a degree of hydrolysis of 75 to 92% and (C) a starch, wherein the weight ratio of A:B is from 80:20 to 20:80, and the ratio of (A plus B) : C is from 90:10 to 50:50 (page 1, left column, lines 1-9).

With regard to a ratio of storage modulus and a glass temperature instantly claimed in claims 1 and 2, JP-A-43-1487 is silent about it. However, in view of substantially identical polyvinyl alcohol composition between JP-A-43-1487 and instant claims, it is the examiner position that JP-A-43-1487's polyvinyl alcohol composition inherently possesses these properties. Since the USPTO does not have equipment to do the analytical test, the burden is now shifted to the applicant to prove otherwise. **In re Fitzgerald** 619 F 2d 67, 70, 205 USPQ 594, 596 (CCPA 1980).

With regard to the limitations of claims 8-10, JP-A-43-1487 discloses the usage of 40 parts of wheat starch (which is chemical), 4 parts of ethylene glycol as plasticizer,

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and 400 parts of water (Example 1, page 2, right column, lines 9-10).

With regard to the limitations of claims 12-19, JP-A-43-1487 discloses that because of the content of starch in a specific ratio, the film is less sensitive to humidity and have a decreased blocking property than conventional films, and, therefore, its workability is extremely improved even under high humidity. Also, the film can be applied to usual printing machines, bag making machines or automatic wrapping machines without any trouble, and when the film is applied to these machines, it shows a sufficient tensile strength such that it can be treated at the same speed as cellophane or a polyethylene film (page 1, right column, lines 2-19).

2. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP-A-43-1487 in view of Nishiguchi et al. (JP 10-060207).

With regard to the limitations of claim 7, JP-A-43-1487 does not disclose that polyvinyl alcohol film further contains inorganic filler (B) having an average particle size of 1 to 10  $\mu\text{m}$ .

Nishiguchi discloses a water-soluble film comprises (A) a modified polyvinyl alcohol and (B) preferably 2-20 wt.% (based on the component A) of fine powder such as clay which has « 150  $\mu\text{m}$  average particle diameter (abstract). Such class of insoluble or poorly soluble impalpable powder can include clay, kaolin, an aluminum hydroxide, a calcium carbonate, a titanium hydroxide, etc. (page 3, [0025]).

Both references are analogous art because they are from the same field of endeavor concerning water-soluble film compositions comprising polyvinyl alcohol and additional ingredients.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate inorganic fine powder having an average particle diameter less or equal to 150  $\mu\text{m}$  as taught by Nishiguchi into the pressure sensitive adhesive composition of JP-A-43-1487's polyvinyl alcohol film composition because all of such impalpable powder prevent the stickiness accompanying moisture absorption and its effect on film physical properties is suppressed (JP'207, page 3, [0026]), and thus to arrive at the subject matter of claim 7.

Thus, the combination of JP-A-43-1487 and Nishiguchi renders all instant claims *prima facie* obvious in view of absent of unexpected results commensurate in scope of claims.

### ***Conclusion***

Other references are considered pertinent to the Applicant disclosure but not cited in this office include U.S. Patents 4,119,604, 4,155,971, 4,156,047 and 5,665,824 are shown on the Notice of References Cited Form (PTO-892).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bernshteyn whose telephone number is 571-272-2411. The examiner can normally be reached on M-F 8-5:30.

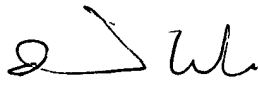
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on 571-272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael Bernshteyn  
Patent Examiner  
Art Unit 1713

MB  
03/23/2006



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